

**REMARKS**

Claims 1-21 are pending in the current application. Claim 1 is the sole independent claim. No new matter has been added. In view of the following remarks, favorable reconsideration and withdrawal of the restriction requirement is respectfully requested.

**AMENDMENTS TO THE CLAIMS**

Applicant respectfully notes that claim 18 (previously dependent from claim 16) has been amended to depend on claim 17.

**RESTRICTION REQUIREMENT**

The Examiner required restriction of one of the following inventions:

- I. Claims 1-16, drawn to a composition for preparing a film, classified in class 524, subclass 714.
- II. Claims 17 and 18, drawn to a method of forming films, classified in class 427, subclass 327.2.
- III. Claims 19-21, drawn to porous films, classified in class 428, subclass 631.

In response to the Examiner's restriction/election requirement, Applicant elects, with traverse, to prosecute Group I including claims 1-16. Applicant specifically reserves the right to file a divisional application directed to non-elected claims 17-21.

With respect to Applicant's traversal, the MPEP explicitly prohibits such a restriction requirement. See below.

Where a combination *as claimed* sets forth the details of the subcombination *as separately claimed*, there is **no** evidence that the combination AB<sub>SP</sub> is patentable without the details of B<sub>SP</sub>. The inventions are **not** distinct and a requirement for restriction must **not** be made or maintained, even if the subcombination has separate utility. This situation can be diagrammed as combination AB<sub>SP</sub> ("sp" is an abbreviation for "specific"), and subcombination B<sub>SP</sub>. Thus the specific characteristics required by the subcombination claim B<sub>SP</sub> are also required by the combination claim.

MPEP § 806.05(c)(I).

In the present application, group I (claims 1-16) may be represented by B<sub>SP</sub> and groups II (claims 17 and 18) and III (claims 19-21) may be represented by AB<sub>SP</sub> wherein the patentability of groups II and III depends on the patentability of group I. For example, independent claim 1 recites,

A composition for preparing a porous dielectric thin film which comprises, (1) a pore generating material of gemini detergent...; (2) thermo-stable organic or inorganic matrix precursor; and (3) a solvent..."

Claim 17 recites "coating the composition of claim 1 on a substrate." Claim 19 recites "[a] substance having nano-pores, said substance being prepared by the composition of claim 1." Claim 20 recites "[a] porous dielectric thin film produced from the composition of claim 1." Even if the Examiner believes that groups II and III have separate utility, a restriction requirement is improper.

Furthermore, Applicant respectfully directs the Examiner's attention to MPEP. § 803 which states:

"If the search and examination of an entire application can be made without serious burden, the Examiner must examine on the merits, even though it includes claims too distinct or independent invention."

Emphasis Added.

There are two criteria for a proper requirement for restriction. The invention should be independent or distinct, and

"2) there must be a serious burden on the Examiner if a restriction is not required. See M.P.E.P. §803.092, 806.04 A through J, 808.01(a) and 808.02." Emphasis Added.

Applicants submit that a) burden cannot be demonstrated at least by the Office Action dated November 15, 2005 in which all of the pending claims were considered, and b) that claims 17-21 are not independent from claims 1-16 at least because of their dependency and patentability as discussed above.

For all of the above stated reasons, reconsideration and withdrawal of the outstanding restriction/election requirement and favorable allowance of Groups I, II and III in the instant application are earnestly solicited.

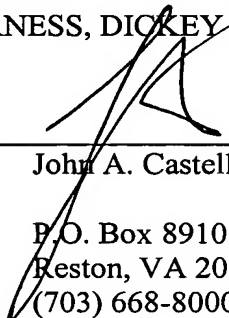
In the event the Restriction Requirement is not withdrawn, the Examiner is respectfully requested to contact the undersigned at (703) 668-8000 to discuss the matter.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

HARNESS, DICKEY & PIERCE, PLC

By

  
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